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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,400	12/18/2000	Robert Delee Bones	AUS920000798US1	5848
35525	7590	10/18/2006	EXAMINER	
IBM CORP (YA)			HENNING, MATTHEW T	
C/O YEE & ASSOCIATES PC				
P.O. BOX 802333			ART UNIT	
DALLAS, TX 75380			PAPER NUMBER	
			2131	

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/740,400

Applicant(s)

BONES ET AL.

Examiner

Matthew T. Henning

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-19 and 39-57 is/are allowed.
- 6) ☒ Claim(s) 20-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. <u>10/2/2006</u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

This office action is in response to the decision by the BPAI rendered 6/27/2006.

### **DETAILED ACTION**

Although the rejections presented in the Final Office action dated 11/24/2004 were fully reversed by the decision rendered by the BPAI on 6/27/2006, a new issue has come to the examiner's attention regarding the patentability of claims 20-38. This is an issue regarding the subject matter being claimed and the USPTO's current stance on the patentability of a computer program listing embodied only as energy. The USPTO's current stance is outlined in the "Interim Guidelines for examination of Patent Applications for Patent Subject Matter Eligibility". The rejection under 35 USC 101, presented below, was not previously presented in this application because at the time of Final Rejection these guidelines were not available, and it appeared to the examiner that, at the time of rejection, the office's stance was that a computer program product residing on computer readable media was statutory.

Furthermore, as detailed in the attached interview summary, the applicant has refused to allow the examiner to amend the claims in order to place them in condition for allowance, and instead has decided to "fight the office" in this matter. As such, a new rejection, consistent with the USPTO's current stance on statutory subject matter, is presented below. Therefore, prosecution has been reopened under 37 CFR 1.198.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 20-38 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims are directed to a "computer program product in computer readable media." Appellant's specification, page 25, lines 15-18, provides intrinsic evidence through examples that Appellant intends for such computer readable media to include "digital and analog communication links." In the event that such "digital and analog communication links" (hereinafter "links") are intended to be limited to the hardware and software necessary to transmit, transport, receive and process the computer program product in such a manner as to enable the computer program product to act as a computer component and realize its functionality, it is believed that the claims in question would be directed to patent-eligible subject matter (statutory). However, no such evidence that the embodiment covered by the claims in question which is directed to the "links" is limited to inclusion of such hardware and software elements exists. Therefore, it is believed that the "links" would reasonably be interpreted by one of ordinary skill as the abstract idea of any portion of a communication, including the forms of energy, *per se*, used in communications. Absent recitation of the hardware, the claims appear devoid of any physical articles or objects which may cooperate to achieve some function, and as such are not directed to a machine. Likewise, absent any such physical article or object, they cannot be directed to a manufacture. They are clearly not a series of steps or acts themselves, and as such are not a process. They are clearly not a composition of

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matter. Therefore, the claims in question do not appear to fall within a statutory category of invention as set forth in 35 USC 101.

***Allowable Subject Matter***


Claims 1-19, and 39-57 are allowed.

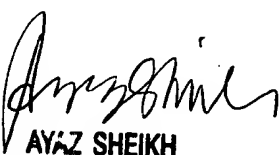
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew T. Henning whose telephone number is (571) 272-3790. The examiner can normally be reached on M-F 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Matthew Henning  
Assistant Patent Examiner  
Art Unit 2131  
10/2/2006

  
AYAZ SHEIKH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100

  
Jack B. Harvey, Director  
Technology Center 2100